

Appl. No. 09/680,172  
Amdt. dated August 27, 2003  
Reply to Office action of May 27, 2003

## REMARKS

As a result of this amendment, claims 1-12 and 14-19 have been cancelled. These claims have been cancelled in order to reduce issues for an appeal if the remaining claims are not allowed or the final rejection is not withdrawn by the Examiner.

### Claim Rejections -- 35 USC §103

According to the MPEP, section 2143, the Examiner must establish three basic criteria to form a *prima facie* rejection based on obviousness. First, there must be some suggestion or motivation, either in the knowledge generally available or to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be some reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claimed limitations.

*In re Fine*, 837 F.2d 1071, 350, 5 USPQ 2d 1596 (C.A.F.C. 1992) states:

"The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lalu*, 747 F.2d 703, 705; 223 USPQ 1257, 1258 (Fed. Cir. 1984) ... [Other references omitted] ... This it has not done. The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention."

And further:

"Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art". *In re Keller*, 642 F.2d 413; 208 USPQ 871 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination". *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* Here, the prior art contains none."

### Examiner's Rejection

The Examiner has rejected claims 1-20 under 35 USC §103(a) as being unpatentable over Popcock (US 6,314,577) or as being unpatentable over Popcock (US 6,314,577) in view of Official Notice. The Examiner states that Popcock '577 provides all the steps of the claimed methods except that the communication device of Popcock '577 is not portable. The Examiner points to Popcock '577, column 2, lines 37-45; and column 3, line 57, to column 4, line 11 as support for his rejection.

Appl. No. 09/680,172  
Amtd. dated August 27, 2003  
Reply to Office action of May 27, 2003

The applicant traverses the Examiner's position with relation to claims 20 and 13 for at least the following reasons.

There are fundamental differences between the method claimed in the present invention and that shown by Popcock. Popcock requires a complex method of obtaining playlists for every radio station. A caller must know the station and time that the music was being played. The listener must remember the song while he listens to predetermined portions of songs from playlist for a particular station near the time the caller specified.

#### Claim 20

Claim 20 requires the steps of "providing a portable communication device" and "transmitting a segment of music playing on a radio to a music identification/purchasing system using said portable communication device". The Examiner states that this is disclosed by Popcock '577, at column 2, lines 37-45. This section of Popcock states that it is an object of the invention to enable "a radio listener to use their telephone to recall and preview, on-demand, music pieces previously broadcast". There is no transmission of music playing on a radio through the portable communication device to a music identification/purchasing system. On the contrary, Popcock '577, column 2, lines 37-45 requires that the listener uses their telephone to listen to music that was previously broadcast to obtain more information regarding the music. The method of Popcock '577, therefore requires that the radio station is known to the caller and that the music programming for the station has been previously entered into their system for sequential playback under directions from the caller. Using the method of the present invention, the listener merely calls a number to hook up to the music identification/purchasing system and holds the phone up to the radio to transmit the music playing on the radio.

Claim 20 requires the steps of "entering said transmitted segment of music into a central processing unit of said music identification/purchasing system" and "analyzing and comparing said transmitted segment of music to music contained in a music database". Again the Examiner states that this is disclosed by Popcock '577, at column 2, lines 37-45. However, this section of Popcock '577 does not relate to "entering a transmitted segment of music" into their system. The music is already resident on their system and is merely ordered in relation to their broadcast time. The caller, having identified the station and a time or time range, listens to the resident music playback and compares them to his memory of a particular song that he heard. The music played back is only a predetermined portion of the music played at a particular time on a particular station and may not be identifiable to the caller by the playback. In contrast, the method of the present invention allows the transmitted segment of music playing on the radio to be analyzed and directly compared to an entire database of musical works. Claim 20 requires a music to music comparison after the transmitted music is entered into the computer processing unit, not a persons recollection of a musical work played on a radio compared to the person's listening of a playback segments of music played on the identified music station.

Claim 20 requires the step of "identifying a music selection providing the closest match from music contained in the music database to said transmitted segment of music". Again, there

Appl. No. 09/680,172  
Amtd. dated August 27, 2003  
Reply to Office action of May 27, 2003

is no transmitted music segment for comparison to the music in the database – therefore it is impossible to identify a closest match as claimed in the present invention by using the method of Popcock '577. The Examiner states that this step is disclosed in Popcock '577, column 3, line 57, to column 4, line 11 as support for his rejection. This section of Popcock refers to an automated system for incorporating a radio station playlist directly from a radio station into a programmed data processor. This section does not refer to an identification step as claimed in claim 20.

Claim 20 is now believed to be distinguished over Popcock '577 and appropriate action by the Examiner is requested.

### Claim 13

Claim 13 is similar to claim 20 with the primary difference that the portable communication device is used to record a segment of music playing on a radio for later transmission to a music identification/purchasing system.

Claim 13 requires the steps of "providing a portable communication device" and "recording a segment of music playing on a radio using said portable communication device". While the Examiner has stated that the that Popcock '577 provides all the steps of the claimed method except that the communication device of Popcock '577 is not portable, the communication device of Popcock '577 is disclosed as a telephone used by the listener to identify a radio station and scroll through a sample of portions of music from a play list. Popcock '577 does not disclose the step of recording a segment of music while it is playing on the radio.

Claim 13 requires the step of "transmitting said recorded musical segment from said portable communication device into a central processing unit". As discussed above, Popcock does not disclose the step of recording a segment of music while it is playing on the radio – therefore Popcock can not disclose the step of transmitting that recorded broadcast segment to a central processing unit. The Examiner states that this step is disclosed by Popcock '577, at column 2, lines 37-45. This section of Popcock states that it is an object of the invention to enable "a radio listener to use their telephone to recall and preview, on-demand, music pieces previously broadcast". There is no transmission of recorded music from the portable communication device to a music identification/purchasing system. On the contrary, Popcock '577, column 2, lines 37-45 requires that the listener uses their telephone to listen to music that was previously broadcast to obtain more information regarding the music. The method of Popcock '577, therefore requires that the radio station is known to the caller and that the music programming for the station has been previously entered into their system for sequential playback under directions from the caller. Neither is required by the method of the present invention.

Claim 13 requires the step of "analyzing and comparing said musical segment to a database of musical works" Again the Examiner states that this is disclosed by Popcock '577, at column 2, lines 37-45. However, this section of Popcock '577 does not relate to "entering a transmitted segment of music" into their system. The music is already resident on their system and is merely ordered in relation to their broadcast time. The caller, having identified the station

Appl. No. 09/680,172  
Amtd. dated August 27, 2003  
Reply to Office action of May 27, 2003

and a time or time range, listens to the resident music playback and compares them to his memory of a particular song that he heard. The music played back is only a predetermined portion of the music played at a particular time on a particular station and may not be identifiable to the caller by the playback. In contrast, the method of the present invention allows the transmitted segment of music playing on the radio to be analyzed and compared to an entire database of musical works. This provides a music to music comparison after the music playing on the radio is recorded by the listener and transmitted to the computer processing unit, not a person's recollection of a musical work played on a radio compared to the person's listening of a playback segments of music played on the identified music station.

Claim 13 requires the step of identifying at least one closest match. Again, there is no recorded and transmitted music segment for comparison to the music in the database – therefore it is impossible to identify a closest match as claimed in the present invention by using the method of Popcock '577. The Examiner states that this step is disclosed in Popcock '577, column 3, line 57, to column 4, line 11 as support for his rejection. This section of Popcock refers to an automated system for incorporating a radio station playlist directly from a radio station into a programmed data processor. This section does not refer to an identification step as claimed in claim 13.

Claim 13 is now believed to be distinguished over Popcock '577 and appropriate action by the Examiner is requested.

In view of the claim amendments and of the arguments set forth above, prompt reconsideration and allowance of the claims is earnestly requested.

Respectfully submitted,

HAHN LOESER & PARKS, LLP

By Robert J. Clark  
Robert J. Clark  
Reg. No. 45,835  
Tel.: (330) 864-5550  
Fax: (330) 864-7986

FAX RECEIVED

AUG 28 2003

GROUP 3600

OFFICIAL